

## **II. REMARKS**

### **A. Status of the Claims**

Claims 1-19 will be pending after this amendment has been entered. Claims 10 and 11 have been withdrawn, as they do not read on the elected species. Claims 20-22 have been withdrawn, as they do not read on the elected invention. Claims 23-42 were previously cancelled. Applicants respectfully submit that no new matter has been added by virtue of this amendment.

### **B. Restriction under 35 U.S.C. 121 and 372**

In the Office Action, the Examiner restricted the pending claims into patentably distinct inventions as follows:

Group I: claims 1-19, drawn to a method of analyzing a nucleic acid; and

Group II: claims 20-22 drawn to kits comprising a means to remove a nucleic acid contaminant.

Applicants respectfully submit that the Restriction Requirement is improper and request reconsideration and withdrawal of the Restriction Requirement. However, for purposes of expediting prosecution of the subject application, Applicants elect, with traverse for the reasons stated below, the invention of Group I, i.e., claims 1-19. Claims 20-22 have been withdrawn without prejudice, as they are part of the non-elected invention.

The Examiner stated that "[t]he inventions listed as Groups I and II do not relate to a

single general inventive concept... because... they lack the same or corresponding special technical feature." Applicants respectfully disagree and point out that, at a minimum, independent claim 1 recites a "single general inventive concept", namely a "method of analysing nucleic acid sample obtained from a site comprising the step of pretreating the sample to remove or inactivate contaminating nucleic acids", and independent claim 20 recites the same "single general inventive concept", namely "a means to remove a nucleic acid contaminant from a sample to be subjected to analysis".

The MPEP states:

An application may be properly required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct.

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

See MPEP 8<sup>th</sup> Ed. 2<sup>nd</sup> Rev. §803

Applicants submit that the present claims are not independent or distinct, as they are linked by a single inventive concept via Group I, i.e., a method of analysing a nucleic acid sample obtained from a site comprising the step of pretreating the sample to remove or inactivate contaminating nucleic acids. The kits of Group II are used to carry out the method of Group I.

Furthermore, Applicants submit that there would be no serious burden on the Examiner to examine all of the present claims, as they all share the same inventive concept, as discussed

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above.

Accordingly, since all of the previous claims 1-22 are all directed to a single dependent invention and examination would not inflict a serious burden on the Examiner, the Examiner is respectfully requested to reconsider and withdraw the Restriction Requirement.

The Examiner also required election of the following species:

Species I (Enzymatic treatment)- claims 8 and 9 for Group I; claim 22 for Group II;

Species II (Physical treatment)- claims 8 and 10 for Group I; claim 21 for Group II; and

Species III (Chemical treatment)- claims 8 and 11 for Group I; claim 22 for Group II.

In response, Applicants hereby elect, without traverse, Species I, i.e., “enzymatic treatment”. Claims 10 and 11 have been withdrawn as they do not read on the elected species.

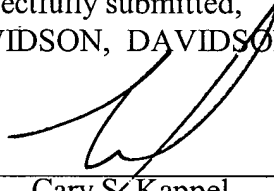
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### III. CONCLUSION

It is believed that no fee is due in connection with the submission of this response. In the event that any fee is deemed due, the Commissioner is hereby authorized to charge such fee to Attorney Deposit Account No. 50-0552.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,  
DAVIDSON, DAVIDSON & KAPPEL, LLC

By:   
Cary S. Kappel  
Reg. No. 36,561

Davidson, Davidson & Kappel, LLC  
485 Seventh Avenue, 14<sup>th</sup> floor  
New York, New York 10018  
(212) 736-1940